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DATE: October 21, 2004 **MATTER NUMBER:** 01035 10408803

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RE: USSN 10/726,258

NUMBER OF PAGES INCLUDING COVER PAGE: 4

Message:

Dear Sir:
As requested by Examiner Bui, attached is a copy of the Decision on Petition, which was mailed June 29, 2004, in this application.

Respectfully submitted,
Mary Anne Schofield
Reg. No. 36,669

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OFFICE OF PETITIONS

In re Reissue Application No. 10/726,258
Filed: January 9, 2003
Original Patent No 6,613,319
Issue Date: September 2, 2003
Original Application No. 09/091,134
Filed: June 23, 1998 (CPA 12/18/00
Inventor: Leiden

: Decision on Petition:

This is a decision on the petition filed December 1, 2003, requesting under 35 U.S.C. §§ 119 and 120 and their promulgating regulations 37 CFR 1.55 and 1.78 acceptance of the accompanying claim for priority, which is being treated as a petition under 37 CFR 1.78.

The petition is dismissed as moot.

Petitioner seeks to amend the as- issued claim of benefit from:

"This application is a continuation in part of U.S. Provisional Patent Application Ser. No. 60/024,511 filed Aug, 23, 1996 the disclosure of which is incorporated by reference" [1] to read:

--This application is a national stage application of International Application No. PCT/US97/14764 filed August 22, 1997, which claims the benefit of provisional application U.S. Ser. No. 60/024,511 filed August, 23, 1996 the disclosure of which are incorporated by reference.--

As background, prior application No. 09/091,134 represents the entry into the national stage on June 23, 1998, of PCT/US97/14764 filed August 22, 1997. However, as filed

[1] As noted in MPEP 1817.02, which cites PCT Rule 4, an applicant may desire that an international application be treated in any designated state as a continuation or continuation in part of an earlier application. The United States was, *inter alia*, a designated state for PCT/US97/14764 filed August 22, 1997.

the national stage application itself claimed benefit under 35 U.S.C. § 120 in the first line of the specification by specifying a relationship (continuation in part) of the prior provisional application, which also appeared in the as issued patent. In turn, on December 18, 2000, a CPA of the prior national stage application was filed under the provisions of 37 CFR 1.53(d)

While the inclusion of the PCT application No in the current § 120 statement is not necessary to obtain benefit; it does no harm. In any event, the petition for an unintentionally delayed claim for benefit of the PCT application under 37 CFR 1.78(a)(3) is moot in the instant CPA. See 37 CFR 1.78((2)(I), which specifically speaks to the instant situation. Furthermore, any claim for benefit of the provisional application on a basis other than under § 120, as *e.g.*, under § 119(e) and 37 CFR 1.78(a)(6), is barred. That is, as noted in MPEP 1481, Section 4503 of the American Inventor's Protection Act of 1999 (AIPA) amended 35 U.S.C. § 119(e)(1) to state that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section during the pendency of the application. (emphasis added)

35 U.S.C. 119(e)(1), as amended by the AIPA, clearly prohibits the addition or correction of priority claims under 35 U.S.C. 119(e) when the application is not pending, *e.g.*, as here, an issued patent. Since the prior PCT application–as well as the CPA-- is no longer pending but is an issued patent, applicant is barred from trying to present or change the current § 120 claim for benefit of the provisional to one under § 119(e).

No basis is given or apparent for invoking 37 CFR 1.55, which pertains to unintentionally delayed claims for foreign priority. Under the facts of this case, the PCT (international) filing date is by law, the filing date of the above-identified national stage application, since it designated the United Sates, and as such has the effect of a U.S. national stage application. See 35 U.S.C. § 363. However, U.S. national priority issues are covered by 37 CFR 1.78(a)(3) and (a)(6); 37 CFR 1.55 is inapposite Pursuant to 35 U.S.C. § 365(c), the international application was entitled to claim benefit of the prior

provisional (a national application) under 35 U.S.C. § 120, which was in fact claimed from the onset of entry into the national stage. To the extent the petition seeks consideration under 37 CFR 1.55, it is necessarily dismissed.

Of particular relevance to the instant situation is MPEP 201.11, subsection B entitled "Reference to Prior Provisional Application" which indicates that where, as here, a relationship was stated between the prior provisional and subsequent non provisional application when the priority claim was made, such is construed as a claim for benefit under section 120 of the prior provisional and not a section 119(e) claim for benefit. The distinction is that when a claim for benefit of a prior provisional–or nonprovisional–application is made under § 120, the 20 year term for the referencing patent is measured from the filing date of the prior provisional or prior nonprovisional, see 35 U.S.C. § 154(a)(2) whereas when the claim for benefit of the same provisional application is made under section 119(e), the term of the referencing patent is not measured from the filing date of the provisional application, see 35 U.S.C. § 154(a)(3).

Lastly, it should be noted that by statute, the USPTO is only empowered to reissue a patent for the unexpired part of the term of the original. See 35 U.S.C. § 251¶ 1 ("the Director shall...reissue the patent... for the unexpired part of the term of the original patent."). Thus, while the instant reissue by way of amendment apparently seeks to recast the claim for benefit of the prior provisional application from one made under section 120 to one now made under section 119(e), the term of the original patent was, as issued, measured from the filing date of the provisional application, and assuming that a reissue patent is granted to the above-identified reissue application, such will not operate to change the term of any forthcoming reissue patent. Compare 35 U.S.C. § 251 ¶1, with 35 U.S.C. §154(a)(2).

Since neither 37 CFR 1.78 nor 37 CFR 1.55 apply to the instant situation, the $1330 petition fee has been credited to deposit account No. 08-0219.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-1820.

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy